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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/689,014	10/20/2003	P. Douglas Kiester	UCI.PAU.24	4115												
23386 7590 10/29/2007 MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD., SUITE 1150 IRVINE, CA 92612			<table border="1"><thead><tr><th colspan="2">EXAMINER</th></tr></thead><tbody><tr><td colspan="2">GETTMAN, CHRISTINA DANIELLE</td></tr></tbody></table> <table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>3734</td><td></td></tr></tbody></table> <table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>10/29/2007</td><td>PAPER</td></tr></tbody></table>		EXAMINER		GETTMAN, CHRISTINA DANIELLE		ART UNIT	PAPER NUMBER	3734		MAIL DATE	DELIVERY MODE	10/29/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/689,014

Applicant(s)

KIESTER, P. DOUGLAS

Examiner

Christina D. Gettman

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-22, 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 11-13 and 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in a telephone call made to Daniel Dawes on December 18, 2006.

Claims 1-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 20, 2007.

Applicant's election with traverse of Invention II in the reply filed on February 20, 2007, is acknowledged. The traversal is on the ground(s) that the method and apparatus cannot be separated because references describing methods of use also describe mechanical methods for making the use. This is not found persuasive because the method does not require the particulars of the apparatus. For instance, the method does not require that the device have a handpiece or be used with a catheter. The method, as stated in the restriction requirement, can be performed using a number of different apparatuses including a meat cutter, a saw, etc.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

Claims 14 and 26 are objected to because of the following informalities: in line 5 and line 4, "a oscillatory rate" needs to be changed to --an oscillatory rate--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dion (U.S. Patent No. 5,913,867). Dion disclose the invention substantially as claimed including a method of oscillating a high speed surgical burr(ref. 18) including the steps of providing a motive source (ref. 114), connecting the source with a drive shaft to the burr (col. 3, lines 48-51), oscillating the burr at a rate to cut bone (col. 4, lines 1-3; col. 7, lines 32-33) and oscillating over only a portion of a full circle (see page 14 of Applicants remarks from August 13, 2007; col. 7, line 24)), providing a burr that is unshielded (see Fig. 1-2 and 4), cooling and clearing the burr by fluid irrigation and fluid (col. 3, lines 28; col. 7, lines 11-16; ref. 118), and removing debris by suction (ref. 96; col. 3, lines 55-58). Although Dion discloses having an inner tube rotation rate of, for example, between 100 rpm and 5000 rpm, it would have been obvious to one having ordinary skill in the art to have changed the motor to be able to produce higher rotation speeds, such as those set forth in the claim limitations: Dion

Art Unit: 3734

also discloses that the surgeon controls the instrument speed. Therefore, since higher oscillatory rates will cut bone and not soft tissue, the surgeon can maintain high oscillatory speeds to do so.

Claims 19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dion as applied to claims 14 and 20 above, and further in view of Wulfman et al. (U.S. Patent No. 2002/0007190). Dion discloses the invention substantially as claimed except for a slip clutch and a telescoping drive shaft and driving shaft. Wulfman et al. teach a resiliently biased slip clutch for the purpose of coupling the drive shaft assembly to the burr by (see Fig. 3) and having an overlapping portion of a drive shaft and driven shaft that are telescopically over each other (see Fig. 3) for the purpose of moving the burr. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Dion with a slip clutch in order to hold the drive shaft assembly onto the burr and to have modified Dion with an overlapping portion of a drive shaft and driven shaft that are telescopically over each other in order to oscillate the burr to cut bone.

### ***Response to Arguments***

Applicant's arguments with respect to claims 14-22 and 26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

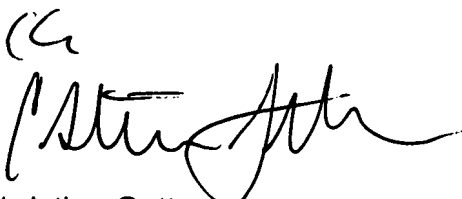
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina D. Gettman whose telephone number is 571-

Art Unit: 3734

272-3128. The examiner can normally be reached on Monday-Friday 7:15 am to 3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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571-272-3128



MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER